

Notice of Allowability

Application No.

10/667,188

Examiner

Evelyn Huang

Applicant(s)

IGUCHI ET AL

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 4-14-2005.
2. ☒ The allowed claim(s) is/are 13-18,21 and 22.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

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EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Forman on 6-29-2005. During the interview, the examiner suggested deleting 'preventing' from claims 21-22 to be commensurate with the scope of objective enablement, and amending claims 13, 17 and 18 to better define the claims to place the application in conditions for allowance.

The application has been amended as follows:

- a. Claim 13, last line, replace 'including' with – or --.
- b. Claim 17, last line, replace 'any of which may take the form of a pharmaceutically acceptable salt ' with – or the pharmaceutically acceptable salts thereof --.
- b. Claim 18, replace 'The compound of claim 13, which is formulated as a pharmaceutical composition alone or in combination with at least one' with – A pharmaceutical composition comprising a compound of claim 13, and optionally in combination with a --.
- c. Claim 21, line 1, delete 'preventing'.
- d. Claim 22, line 1, delete 'preventing'.

REASONS FOR ALLOWANCE

2. The following is an examiner's statement of reasons for allowance:

Claims 13-18, 21, 22 are allowed.

The rejection for claims 19-20 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is rendered moot by the cancellation of these claims.

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The enablement rejection under 35 U.S.C. 112, first paragraph is withdrawn upon reconsideration in view of the cancellation of claims 19-20 and the amendment to claims 21-22.

The rejection for Claims 13-20 under 35 U.S.C. 103(a) as being unpatentable over Uchida (6624162, with an effective filing date of 10-2-2001, and is available as prior art under 102(e)) is withdrawn upon reconsideration in view of the showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a) according to MPEP § 706.02(l)(1) and § 706.02(l)(2). Furthermore, the inventive compound has an unexpectedly higher TI values than the closest prior art compounds described in claim 7 of Uchida (pages 19-20 of the specification), thereby rendering the instant unobvious over Uchida.

The obviousness-type double patenting rejection over claims 1-11 of U.S. Patent No. 6624162 and the provisional obviousness-type double patenting rejections over the claims of copending Application No. 10/617920 (division of 6624162) are withdrawn upon reconsideration in view of the unexpected results exhibited by the inventive compound over Uchida's claimed compounds. The TI values of the inventive compounds are unexpectedly higher than the closest prior art compounds described in claim 7 of Uchida (pages 19-20 of the specification), thereby rendering the instant unobvious over Uchida.

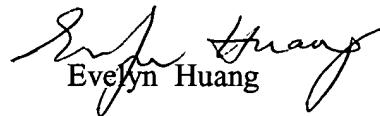
3. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn Huang whose telephone number is 571-272-0686. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Evelyn Huang

Primary Examiner

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